

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/319,806 08/19/99 CRAMERI

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EXAMINER

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255 EAST FIFTH STREET
CINCINNATI OH 45202

NOLAN, P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1644

DATE MAILED: 07/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.**Commissioner of Patents and Trademarks**

| | | |
|------------------------------|--------------------------------------|--------------------------------------|
| Office Action Summary | Application No. 09/319,806 | Applicant(s) Cramer et al. |
| | Examiner Patrick Nolan | Art Unit 1644 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on Apr 13, 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3, 6-9, and 14 is/are rejected.
- 7) Claim(s) 4, 5, 10-13, and 15-20 is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) Interview Summary (PTO-413) Paper No(s). _____
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other: _____

Part III DETAILED ACTION

1. Claims 1-20 are pending.

The following new ground of rejections is necessitated by Applicant's amendment filed 4-13-01

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-3, 6-9 and 14 are rejected under 35 U.S.C. § 103 as being unpatentable over Little et al. (IDS).

Little et al., teaches the diagnosis of ABPA in a human individual wherein said individual comprises antibodies to A. Fumigatus non secreted protein, gp66, that can discriminate between ABPA and allergic sensitization to A. Fumigatus (see fig 4., and page 56, 2nd column under allergen identification, in particular) in an ELISA where IgE class antibodies are determined (Fig. 4, in particular) and wherein an in vivo ABPA allergen skin prick test is carried out in the individual (see methods).

The claimed invention differs from the prior art teachings only by the recitation that said ABPA related allergen is

Art Unit: 1644

recombinant. However, Ex parte Goldgaber, 41 USPQ2d 1172, recognized that "real world workers in this field (i.e. molecular biology) who isolate proteins are clearly "motivated" to determine the nucleotide sequences that code for such proteins so that increased quantities of the protein may be produced through recombinant DNA technology" (page 13).

One of ordinary skill in the art at the time the invention was made would have been motivated to make the isolated gp66 protein taught by Little in the method of ABPA diagnosis recombinantly because Ex parte Goldgaber, 41 USPQ2d 1172, recognized that "real world workers in this field (i.e. molecular biology) who isolate proteins are clearly "motivated" to determine the nucleotide sequences that code for such proteins so that increased quantities of the protein may be produced through recombinant DNA technology. From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole is prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references.

3. Applicant is notified that claims 4-5, 10-13 and 15-20 are free of the prior art as of the last art search.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants cooperation is requested in correcting any errors of which applicant may become aware of in the specification.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is (703) 305-1987. The examiner can

Serial Number: 09/319,806
Art Unit: 1644

4

normally be reached on Monday through Friday from 8:30 am to 4:30 pm.

7. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at (703) 305-3973. The FAX number for our group, 1644, is (703) 305-7939. Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 308-0196.

Patrick J. Nolan
Patrick J. Nolan, Ph.D.
Primary Examiner, Group 1640
June 30, 2001